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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	BEFORE THE BOARD OF PATENT
Naohito TOMOE)	APPEALS AND INTERFERENCES
Serial No. 09/225,245)	Appeal No.: 2002-1129
Filed: January 4, 1999)	Examiner: Quochien B. Vuong
For: DEVICE FOR AND METHOD OF)	Group Art Unit: 2685
DETECTING INTERFERENCE)	January 26, 2004
WAVES)	

REQUEST FOR REHEARING UNDER 37 CFR § 1.197(b)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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This is a request for reconsideration of the Board decision dated November 25, 2003, affirming the final rejection of claims 1, 2, 12 and 13 of the above-identified application.

ARGUMENT

The Rejection of Claims 1, 2, 12 and 13 Is Improper

In affirming the rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Yoshimi et al. (U.S. Patent No. 5,603,093, hereinafter "Yoshimi") in view of the admitted prior art ("APA") of Fig. 11 of the present application, the Board

found that the prior art method discussed in the "Background of the Invention" section of Yoshimi is an unpreferred embodiment of the Yoshimi invention. The Board also stated that appellant appears to be attempting to patent the prior method in Yoshimi. Reconsideration of these holdings is requested.

The Background Discussion of Yoshimi Is Not an "Unpreferred Embodiment"

Contrary to the holding in the decision, Yoshimi's discussion of the "conventional system" in columns 1 and 2 does not represent a "non-preferred" or "unpreferred embodiment" of the Yoshimi invention, but rather is a discussion of the prior art to the Yoshimi invention. See Yoshimi at col. 2, 11.2-3 ("it is general practice in the prior art to measure the field intensity of radio waves ..." (emphasis added)).

Neither Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804 (Fed. Cir. 1989), nor In re Lamberti, 545 F.2d 747 (CCPA 1976) stand for the proposition that a discussion of background prior art in a patent reference can constitute an "unpreferred embodiment" of the invention taught by that reference. In both Merck and Lamberti, the issue was whether the lack in a prior art reference of an express disclosure of a claimed chemical compound, taken together with a teaching in the reference that a

specific different compound is preferred, renders the claimed compound non-obvious over the prior art reference.

Yoshimi does not suggest that the prior art method of using a dedicated measurement device to measure interference waves in a zone covered by a base station, while the base station is stopped from transmitting radio waves, is a possible, albeit unpreferred, embodiment of the Yoshimi invention. To the contrary, Yoshimi states that the prior art method sometimes leaves a region of an undesired state of reception in the zone (col. 2, ll. 18-20), and further that mobile radio communication service is impaired during the measurement (col. 2, ll. 21-25). As such, Yoshimi clearly does teach away from using the conventional prior art method of interference wave detection using a dedicated measurement device, as discussed in columns 1 and 2 of that reference.

The Yoshimi reference does not have to state or show that the prior art method does not work in order for Yoshimi to teach away from using such method, as asserted in the decision at page 5. Rather, "[a] reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was

taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Clearly, Yoshimi's statement that the prior art method sometimes leaves a region of an undesired state of reception in the zone and that mobile radio communication service is impaired during the measurement, would discourage one of ordinary skill in the art from following the conventional prior art method set out in the Yoshimi reference, and would lead one ordinarily skilled in the art in a direction divergent from the path taken by the present applicant.

Yoshimi Does Not Disclose the Claimed Invention

Applicant does not believe he is entitled to patent the prior art method discussed in Yoshimi. Rather, the invention set forth in claim 12 is neither disclosed nor suggested by Yoshimi. While the Board has noted that the conventional prior art method and the claimed invention of claim 12 both involve stopping of base station transmission, the invention of claim 12 is not directed simply to stopping base station transmission while measuring for interference waves in the base station's zone by a dedicated measurement device as discussed by Yoshimi.

In particular, claim 12 requires the step of converting data to be transmitted from a base station into a radio signal of

predetermined transmission frequency and transmitting it to a mobile station. Claim 12 also requires receiving a radio signal from said mobile station. Thus, claim 12 necessarily describes a method that must be performed by the base station, since only a base station transmits signals to a mobile station, and receives signals from a mobile station.

In this regard, it is noted that the Final Rejection grouped claims 1, 2, 12 and 13 together in discussing the rejection as applied to claim 1, and not applicant. The Final Rejection relies on the APA not to merely show structure, but instead proposes to modify the APA to use the conventional prior art method discussed by Yoshimi. Thus, it is necessary to combine Yoshimi with the APA to reject claim 12, as well as to reject claim 1. Thus, the background discussion in Yoshimi does not anticipate claim 12, as the Board's decision appears to insinuate at page 5.

CONCLUSION

In view of the of the foregoing, the Honorable Board is respectfully requested to reconsider the decision affirming the rejection of claims 1, 2, 12 and 13, and instead to issue a decision reversing this ground of rejection.

Serial No. 09/225,245
Appeal No. 2002-1129

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Respectfully submitted,

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